

**DECLARATION ACCOMPANYING APPLICATION
FOR REISSUE OF U.S. PATENT NO. 5,535,430**

We, Katsuhiko Aoki, Makio Tsuchiya, and Seiya Inoue, hereby declare that:

We are citizens of Japan residing at Hyogo, Japan, and having a post office address c/o Mitsubishi Denki Kabushiki Kaisha, Tsushinki Seisakueno, 1-1, Tsukaguchi-Honmachi 8-chome, Amagasaki-shi, Hyogo, Japan;

We are the inventors of the invention described and claimed in U.S. Patent No. 5,535,430 issued July 9, 1996 and assigned to Mitsubishi Denki Kabushiki Kaisha, a corporation of Japan,

We believe that we are the original, first and joint inventors of the subject matter which is claimed and for which a reissue patent is sought, on the invention entitled MOBILE COMMUNICATION TERMINAL EQUIPMENT USABLE FOR BOTH SATELLITE AND TERRESTRIAL COMMUNICATIONS, the specification of which is attached hereto;

We have reviewed and understand the contents of the above-identified specification, including the claims;

We acknowledge the duty to disclose information which is material to the examination of this reissue application in accordance with Title 37, Code of Federal Regulations, §1.56(a);

We verily believe the original U.S. Patent No. 5,535,430 to be wholly or partly inoperative, for the following reasons:

(a) The above-identified patent is so inoperative by reason of claiming less than we had the right to claim in the patent, in that claim 1 is insufficient.

Specifically,

(i) the invention disclosed in the patent is directed to a novel mobile communication terminal equipment for carrying out communications using both a satellite communication system and a terrestrial mobile communication system, in which a satellite transceiver and a portable handset, disconnectable from the satellite transceiver and including a terrestrial transceiver are provided, with the portable handset including a signal input/output circuit for inputting signals from a user and outputting signals to the user, and a connection controller and switching means for selectively connecting the signal input/output circuit to one of the satellite transceiver and terrestrial transceiver (transmission/reception circuit) when the portable handset is connected to the satellite transceiver, and for connecting the signal input/output circuit to the terrestrial transmission/reception circuit when the portable handset is disconnected from the satellite transceiver;

(ii) in claim 1, the mobile communication terminal equipment is recited as being mountable in a vehicle, with the satellite transceiver being recited as being mountable in the vehicle. However, in actuality the invention is not limited to only vehicle-mounted devices, but is equally applicable to devices which are not mounted in vehicles but are provided in a stand-alone configuration;

(iii) in claim 1, the portable set is set forth as being disconnectable from the satellite transceiver so that the set can be carried by a user. However, it is not necessary for the portable set to be carried by the user once disconnected from the satellite transceiver;

(iv) in claim 15, the signal input/output circuit is set forth as including command input means for inputting user commands. However, it is not necessary for the command input means to be a part of the

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signal input/output means, but rather the command input means can be implemented as part of the connection controller;

(v) as such, a mobile communication terminal equipment which utilized all of the features of the present invention, but which was not mounted in a vehicle or mountable in a vehicle, could be interpreted by a court of law as not literally infringing claim 1. Similarly, equipment which used all the features of the invention but which portable set was not carried by a user, could be interpreted by a court of law as not literally infringing claim 1. Further, equipment which included all the features of the invention but which had command input means not part of the signal input/output circuit, could be interpreted by a court of law as not literally infringing claim 15.

These insufficiencies are remedied by new claims 19-22 which differ from claim 1 in that claims 19-22 do not require that the mobile communication terminal equipment be mountable in a vehicle, nor do these claims require that the portable set be disconnectable from the satellite transceiver so that the set can be carried by a user. Claim 20 sets forth further features of the satellite transceiver, portable set and signal input/output means; claim 21 sets forth further features of the connection controller and control signals, and claim 22 sets forth further features of the connection controller and terrestrial control means.

The errors specified above arose without any deceptive intention on our part;

The undersigned inventors hereby claim foreign priority benefits under Title 35, United States Code, §119 of Japanese patent application no. 5-058612 filed March 18, 1993, a certified copy of which was filed in the original application for U.S. Patent 5,535,430, application Serial No. 208,707 filed March 11, 1994.

POWER OF ATTORNEY

We hereby appoint the following attorneys to prosecute this application and to conduct all business in the Patent and Trademark Office connected therewith, and request that all correspondence about the application be addressed to ROTHWELL, FIGG, ERNST & KURZ, p.c., 555 Thirteenth Street, N.W., Washington, D.C. 20004-1126:

G. Franklin Rothwell, Reg. No. 18,125
E. Anthony Figg, Reg. No. 27,195
Barbara G. Ernst, Reg. No. 30,377
George R. Repper, Reg. No. 31,414
Bart G. Newland, Reg. No. 31,282
Vincent M. DeLuca, Reg. No. 32,408
Celine Jimenez Crowson, Reg. No. 40,357
Joseph A. Hynds, Reg. No. 34,627
Michael G. Sullivan, Reg. No. 35,377
Mark I. Bowditch, Reg. No. 40,315
Robert J. Jondic, Reg. No. 33,913
Kenneth M. Fagin, Reg. No. 37,615
Stephen B. Parker, Reg. No. 36,631
Minaksi Bhatt, Reg. No. 35,447
Don M. Kerr, Reg. No. 22,720
Jeffrey W. Renneckex, Reg. No. 40,784
Jeffrey I. Ihmen, Reg. No. 28,937
Stephen A. Saxe, Reg. No. 38,609
Robert P. Cogan, Reg. No. 25,049

We further declare that all statements made herein of our own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were

made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18, United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

July 6, 1998

Date

Katsuhiko Aoki

Katsuhiko AOKI

July 6, 1998

Date

Makio Tsuchiya

Makio TSUCHIYA

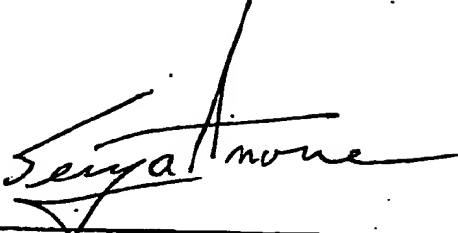
Please see the attached paper for the third inventor.

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The third inventor

July 6, 1998

Date


Seiya INOUE

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For: MOBILE COMMUNICATION)
 TERMINAL EQUIPMENT)
 USABLE FOR BOTH SATELLITE)
 AND TERRESTRIAL)
 COMMUNICATIONS)

OFFER TO SURRENDER PATENT

Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

The undersigned represents that he is an authorized representative of Mitsubishi Denki Kabushiki Kaisha, and that Mitsubishi Denki Kabushiki Kaisha is the sole assignee of U.S. Patent No. 5,535,430 and the accompanying reissue application. Documentary evidence of Mitsubishi's ownership of the subject patent is attached hereto.

Mitsubishi Denki Kabushiki Kaisha assents to the filing of an application for reissue of U.S. Patent 5,535,430 and hereby offers to surrender original Letters Patent No. 5,535,430 upon the grant of a patent on such reissue application. The original

Letters Patent No. 5,535,430 will be submitted to the U.S. Patent and Trademark Office.

I further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

July 6, 1998

Date

K. Yoshida

Typed Name: Kimio YOSHIDA

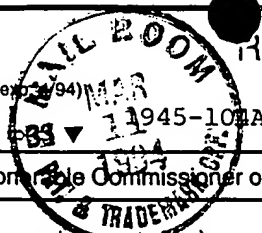
Title: Manager, Patent Administration Department

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U.S. DEPARTMENT OF COMMERCE
Patent and Trademark Office

Tab settings = 83



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To the Honorable Commissioner of Patents and Trademarks: Please record the attached original documents or copy thereof.

1. Name of conveying party(ies):

Katsuhiko Aoki
Makio Tsuchiya
Seiya Inoue

Additional name(s) of conveying party(ies) attached? ☐ Yes ☒ No

2. Name and address of receiving party(ies)

Name: Mitsubishi Denki Kabushiki Kaisha

Internal Address: _____

Street Address: 2-3, Marunouchi 2-chome

Chiyoda-ku

City: Tokyo 100, State: Japan ZIP: _____

Additional name(s) & address(es) attached? ☐ Yes ☒ No

3. Nature of conveyance:

☒ Assignment

☐ Merger

☐ Security Agreement

☐ Change of Name

☐ Other _____

Execution Date: March 4, 1994

4. Application number(s) or patent number(s):

If this document is being filed together with a new application, the execution date of the application is: March 4, 1994

A. Patent Application No.(s)

B. Patent No.(s)

Additional numbers attached? ☐ Yes ☒ No

5. Name and address of party to whom correspondence concerning document should be mailed:

Name: Rothwell, Figg, Ernst & Kurz, P.C.

Internal Address: Suite 701 East

Street Address: 555 13th Street, N.W.

City: Washington, State: D.C. ZIP: 20004

6. Total number of applications and patents involved: 1

7. Total fee (37 CFR 3.41).....\$ 40.00

☒ Enclosed

☐ Authorized to be charged to deposit account

8. Deposit account number:

02-2135

(If any additional fees are due)
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9. Statement and signature.

To the best of my knowledge and belief, the foregoing information is true and correct and any attached copy is a true copy of the original document.

Lawrence G. Norris

Name of Person Signing

Lawrence G. Norris

Signature

March 11, 1994

Date

Total number of pages including cover sheet, attachments, and document: 12

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**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

DATE: 04/15/94

TO:

N06C

ROTHWELL, FIGG, ERNST & KURTZ, P.C.
LAWRENCE G. NORRIS
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555 13TH ST., NW
WASHINGTON, DC 20004

**UNITED STATES PATENT AND TRADEMARK OFFICE
NOTICE OF RECORDATION OF ASSIGNMENT DOCUMENT**

THE ENCLOSED DOCUMENT HAS BEEN RECORDED BY THE ASSIGNMENT BRANCH OF THE U.S. PATENT AND TRADEMARK OFFICE. A COMPLETE MICROFILM COPY IS AVAILABLE AT THE U.S. PATENT AND TRADEMARK OFFICE ON THE REEL AND FRAME NUMBER REFERENCED BELOW.

PLEASE REVIEW ALL INFORMATION CONTAINED ON THIS NOTICE. THE INFORMATION CONTAINED ON THIS RECORDATION NOTICE REFLECTS THE DATA PRESENT IN THE PATENT ASSIGNMENT PROCESSING SYSTEM. IF YOU SHOULD FIND ANY ERRORS OR QUESTIONS CONCERNING THIS NOTICE, YOU MAY CONTACT THE EMPLOYEE WHOSE NAME APPEARS ON THIS NOTICE AT 703-308-9723. PLEASE SEND REQUEST FOR CORRECTION TO: U.S. PATENT AND TRADEMARK OFFICE, ASSIGNMENT BRANCH, NORTH TOWER BUILDING, SUITE 10C35, WASHINGTON, D.C. 20231

ASSIGNOR:
AOKI, KATSUHIKO

DOC DATE: 03/04/94

ASSIGNOR:
TSUCHIYA, MAKIO

DOC DATE: 03/04/94

ASSIGNOR:
INOUE, SEIYA

DOC DATE: 03/04/94

RECORDATION DATE: 03/11/94 NUMBER OF PAGES 002 REEL/FRAME 6917/0362

DIGEST : ASSIGNMENT OF ASSIGNORS INTEREST

ASSIGNEE:
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SERIAL NUMBER 8-208707
PATENT NUMBER

FILING DATE 03/11/94
ISSUE DATE 00/00/00

L. Sturman

EXAMINER/PARALEGAL
ASSIGNMENT BRANCH
ASSIGNMENT/CERTIFICATION SERVICES DIVISION

1995-104A

ASSIGNMENT OF PATENT APPLICATION

WHEREAS, I/we Katsuhiko AOKI, a citizen of Japan,
 residing at c/o Mitsubishi Denki Kabushiki Kaisha, Tsushinki Seisakusho, of 1-1, Tsukaguchi-honmachi 8-chome, Amagasaki-shi, HYOGO 661 Japan,
Makio TSUCHIYA, a citizen of Japan,
 residing at c/o Mitsubishi Denki Kabushiki Kaisha, Tsushinki Seisakusho, of 1-1, Tsukaguchi-honmachi 8-chome, Amagasaki-shi, HYOGO 661 Japan,
Seiya INOUE, a citizen of Japan,
 residing at c/o Mitsubishi Denki Kabushiki Kaisha, Tsushinki Seisakusho, of 1-1, Tsukaguchi-honmachi 8-chome, Amagasaki-shi, HYOGO 661 Japan,
 _____, a citizen of _____,
 residing at _____

ASSIGNOR(S), am/are the inventor(s) of an invention in MOBILE COMMUNICATION TERMINAL EQUIPMENT
USABLE FOR BOTH SATELLITE AND TERRESTRIAL COMMUNICATIONS
 for which I/we have executed an application for Letters Patent of the United States,

(Check One) ☒ of even date herewith
☐ serial number _____,
 filed _____; and

WHEREAS, Mitsubishi Denki Kabushiki Kaisha of 2-3, Marunouchi 2-chome, Chiyoda-ku, TOKYO 100 Japan,
 ASSIGNEE, is desirous of obtaining the entire right, title and interest in, to and under the said invention and the said application;

NOW, THEREFORE, in consideration of the sum of One Dollar (\$1.00) to me/us in hand paid, and other good and valuable consideration, the receipt of which is hereby acknowledged, I/we, the said ASSIGNOR(S) have sold, assigned, transferred and set over, and by these presents do hereby sell, assign, transfer and set over, unto the said ASSIGNEE, its successors, legal representatives and assigns, the entire right, title and interest in, to and under the said invention, and the said application and all divisions, renewals and continuations thereof, and all Letters Patent of the United States which may be granted thereon and all reexamination certificates, reissues and extensions thereof, and I/we hereby authorize and request the Commissioner of Patents of the United States, to issue all Letters Patent for said invention to the said ASSIGNEE, its successors, legal representatives and assigns, in accordance with the terms of this instrument.

AND I/WE HEREBY covenant that I/we have the full right to convey the entire interest herein assigned, and that I/we have not executed, and will not execute, any agreement in conflict herewith.

AND I/WE HEREBY further covenant and agree that I/we will communicate to said ASSIGNEE, its successors, legal representatives and assigns, any facts known to me/us respecting said invention, and testify in any legal proceeding, sign all lawful papers, execute all divisional, continuing and reissue applications, make all rightful oaths and generally do everything possible to aid the said ASSIGNEE, its successors, legal representatives and assigns, to obtain and enforce proper patent protection for said invention at the expense of the ASSIGNEE.

IN TESTIMONY WHEREOF, I/we hereunto set my/our hand(s) and seal(s) the day and year set opposite my/our signature(s).

Katsuhiko Aoki L.S. Date March 4, 1994
Makio Tsuchiya L.S. Date March 4, 1994
Sageatsumi L.S. Date March 4, 1994
_____ L.S. Date _____, 19____

Witness:

Yoshiko Honda March 4, 1994
Yoko Demon March 4, 1994